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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MCCORMICK, SUSAN B

ART UNIT PAPER NUMBER

1661

DATE MAILED: 03/25/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/032,692

Applicant(s)

COLLIDGE, PETER

Examiner

Susan B. McCormick

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detailed Action

The substitution specification of February 3, 2003, is hereby acknowledged and entered as paper no. 4.

The text of those sections of Title 35, U.S. Code not included in this action can be found in the prior Office action.

Claim Rejection- 35 U.S.C. § 112

Claim 1 remains rejected under U.S.C. § 112, first and second paragraph, for reasons stated in the prior Office action (paper no. 2).

Response to Arguments

Applicant argues that the Examiner has not shown how the description of the new plant fails to distinguish the plant from its parent or from other known varieties. This argument is not persuasive as the Examiner has shown, by providing in written detail, (i.e. in Office action A-X, paper no. 2) what the Applicant is missing in order to distinguish it from other known varieties by a detailed botanical description. Applicant has declined to provide this information (paper no. 4).

Applicant argues that a reasonably complete description *does not* include each and every quantifiable feature of the plant. This is not persuasive as Applicant should appreciate that, if the prior art becomes cluttered with vague and incomplete descriptions it would become difficult for the Examiner to distinguish the new plant from the prior art. This would make it harder for future Applicants to obtain patents on their inventions. An example, a plant patent issues on a new variety of plant which, as its distinguishing characteristic, is male sterile. All other traits of the plant are described as "average," "medium" or "typical of the species." If a later Applicant files an application for a male sterile plant, which is also wilting the normal range for the species in morphological characteristics, his claim would be rejected under 35 U.S.C. 102. Since plants within a species do vary in morphology, it is most probable that the two plants are not identical. The Examiner cannot determine this. The later Applicant would then be required to distinguish his plant from the prior art, most likely be growing the two side by side, which would be expensive and certainly shorten the term of the patent. As Applicant points out, a plant patent is intended to cover one specific plant (hence the requirement for specific information).

Applicant argues the addition of unnecessary, vague, or ambiguous information diminishes its value as an aid in identifying the claimed plant. This argument is completely illogical. Applicant also argues that many plant characteristics are variable and only characteristics, which are not variable, should

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be described. In biological systems, almost everything is variable. The Office recognizes that growing conditions influence plant morphology, yield and other characteristics. Examiners typically request that the growing conditions and age of the observed plants to be disclosed, to make the descriptions more meaningful. Furthermore, it is perfectly acceptable for morphological characteristics to be described as a range. Describing the leaf length as "8-10 cm" is more precise than "medium," example, and is certainly more useful for comparing one plant with another.

The information is found in virtually all plant patents and can be readily obtained with a color chart and measuring device. Therefore, the request does not seem to be unreasonable. There is no standard set of descriptions or characteristics required for apples or any other species.

A U.S. Patent Examiner relies exclusively on Applicant's disclosure and the disclosures of the prior art to distinguish the claimed plant from the prior art.

Applicant's amendment dated February 3, 2003, failed to address the following grounds of rejection:

A. Applicant failed to disclose additional information relative to the height and spread for the observed tree at a specified age and location of culture and/or amount of growth over a specified period of time. The recitations "Medium size" and "medium vigour" does not adequately describe the size or vigor of the observed tree. Clarification is needed.

B. Applicant failed to disclose information regarding the size (length and width), average number (per square inch) and color of the lenticels of the branch.

C. Applicant failed to disclose the shape, shape of the apex and base and color (both surfaces) of the observed leaf as well as the leaf's vein color and venation pattern.

D. Applicant failed to disclose the petiole diameter and color.

E. Applicant failed to disclose the size, amount and color of the stipules as "small to insignificant stipule size" is insufficient and vague.

F. Applicant failed to disclose the length, diameter and color of the flower bud.

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G. Applicant failed to set forth the flower diameter, observed number of flowers per cluster and characteristic fragrance (if any).

H. Applicant failed to set forth in the specification the shape, shape of the base and apex, margin, color (both surfaces), and texture of the petal.

I. Applicant failed to set forth in the specification the size (length and width) and color of the sepals. The terms "small" is vague and insufficient in this regard. Correction is needed.

J. Applicant failed to set forth in the specification the reproductive organs. Applicant should disclose information such as the sizes (lengths), number and colors and describe these structures in the interest of providing as complete a botanical description of the observed plant as is reasonably possible.

K. Applicant failed to set forth information relative to pollination requirements of the observed tree.

L. Applicant failed to disclose the diameter of the stem. The recitation "Medium thickness" does not describe the diameter of the stem. Applicant should disclose a quantitative measurement for the diameter. Correction is needed.

M. Applicant failed to disclose the eye adequately. The recitation "Size, medium" does not sufficiently describe the eye.

N. Applicant failed to describe the texture of the flesh of the observed fruit. Applicant should utilize a more appropriate term such as --fine-grained--, --smooth-- or --crisp-- as "Medium" is insufficient in this regard. Correction is needed.

O. Applicant failed to disclose the known shipping and storage characteristics of the observed variety. For example, the number of days the fruit has been stored under specific conditions.

P. Applicant failed to disclose additional information relative to plant/fruit disease resistance/susceptibility in the specification.

R. Applicant failed to disclose information to the observed plant's winter hardiness and drought/heat tolerance.

Conclusion

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick whose telephone number is (703) 305-1682. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 308-0196.


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